

ESTTA Tracking number: **ESTTA704578**

Filing date: **10/26/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91222914
Party	Defendant Qualtrics, LLC
Correspondence Address	SCOTT P SINOR DORSEY & WHITNEY LLP 1400 WEWATTA ST STE 400 DENVER, CO 80202-5549 UNITED STATES docketing-dv@dorsey.com, sinor.scott@dorsey.com, porter.karen@dorsey.com, docket.denver@dorsey.com, pellant.jessie@dorsey.com, wild- in.cindy@dorsey.com
Submission	Answer
Filer's Name	Scott P. Sinor
Filer's e-mail	sinor.scott@dorsey.com, pellant.jessie@dorsey.com, port- er.karen@dorsey.com, docket.denver@dorsey.com
Signature	/s/ Scott P. Sinor
Date	10/26/2015
Attachments	Amended Answer to Notice of Opposition 91222914.pdf(35570 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re: Application Serial No. 86/426,812
For the Mark: VOCALIZE
Filed: October 17, 2014
Published in the Official Gazette: March 24, 2015

Jordan Older)	
)	
Opposer,)	
)	Opp. No. 91222914
v.)	
)	
Qualtrics, LLC)	
)	
Applicant.)	
)	

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

On September 23, 2015 the Board issued an Order requesting Qualtrics, LLC (“Applicant”) to file an Amended Answer to the Notice of Opposition filed by Jordan Older, (“Opposer”) against the subject Application Serial No. 86/426,812 on July 22, 2015. The Board has requested that Applicant number the paragraphs on Opposer’s opposition and then respond to each numbered paragraph. Applicant submits its Amended Answer to Opposer’s Opposition as follows:

1. Qualtrics, LLC, has been very tricky and deceptive, and has admitted in writing (and apologized) to acting in bad faith, in their more than year-long attempt to steal my business name, VOCALIZE, and rights to my company website domain name.

RESPONSE: Applicant denies the allegations contained in paragraph 1 of the Opposition.

2. I have prior use and their (1B) intent to use applications will confuse my customers, prevent me from fully using my company name, domain name, and trademark, and

dilute my ability to get full value and use from my own registered trademarks that I've been using since before 1998. Additionally, as you see below they notified me in writing that they gave up use and abandoned used of the word and domain name Vocalize multiple times and I already own the trademark registration for VOCALIZE in Utah, where Qualtrics is located, in the same and additional classes (see last page of pleading below.)

RESPONSE: Applicant admits the Opposer appears to have applied for a Utah State trademark registration no. 9294372-0190. Applicant denies the remaining allegations in paragraph 2 of the Opposition.

3. I coined the term Vocalize for use on the Internet 17 years ago in 1998 when I was the first ever registrar and owner of the vocalize.com domain name registration. No one else had ever had a website named Vocalize or used the term Vocalize for a service before that time, since the Internet was only less than 4 years old. The domain was purchased to be used for voice instruction and to make a social network for voice teachers and related people and for voice over IP telephone research and development. This is proven by doing a simple search in the Internet archives (Way Back Machine.) I also have own the registration to vocalize.org since 2003. I was the first to register this domain name as well.

RESPONSE: Applicant is without information sufficient to form a belief as to the truth of the allegations contained in the first three sentences and last sentence of paragraph 3 of the Opposition, and therefore denies the same. Applicant denies the fourth sentence and admits the fifth sentence.

4. Qualtrics has been in negotiations to purchase my domain name vocalize.com and my related trademark registrations since they first contacted me in June of 2014.

86384658	4742690	VOCALIZE	TSDR LIVE (registration)
86351698	4738030	VOCALIZE	TSDR LIVE (registration)
86427515		VOCALIZE	TSDR LIVE (application)

RESPONSE: Applicant denies that the parties have been in negotiations since June of 2014, and admits that Applicant is the owner of the two trademark registrations and the application referenced in paragraph 4. Applicant denies that Opposer's trademark application

can be asserted against Applicant in this Opposition. Applicant is without sufficient information to form a belief as to whether the Opposer's first date of use for the registrations or application is in 1998 and therefore denies the same.

5. In 2014 during negotiations to purchase my domain name and trademarks to it, Qualtrics notified me, in writing more than once, that they were no longer interested in and not going to use the mark Vocalize and were going to use a different mark/domain.

RESPONSE: Applicant denies the allegations contained in paragraph 5 of the Opposition.

6. Given this information I started the application to protect my intellectual property by registering trademarks for Vocalize, which have been granted registrations, listed above, already by the USPTO.

RESPONSE: Applicant is without information sufficient to form a belief as to the truth of the allegations contained in paragraph 6 of the Opposition, and therefore denies the same. Applicant specifically denies that all of Opposer's applications have been granted registrations.

7. Only after discovering my trademark applications did Qualtrics, once again, become interested in using Vocalize and make additional offers to buy the domain name from me and they also made their own trademark (1B intent to use) registrations.

RESPONSE: Applicant admits that it filed 1b intent to use trademark applications. Applicant denies the remaining allegations contained in paragraph 7 of the Opposition.

8. Given that Qualtrics has never used the mark prior to them trying to buy it from me in September of 2014 and I have owned it and been continuously using it for 17 years (since 1998) I am opposing this application because if Qualtrics application is successful it will confuse my customers and the general public as to who "is" Vocalize and it will also dilute the distinctive quality of the mark and prevent me from receiving full use and value of my intellectual property.

RESPONSE: Applicant denies the allegations contained in paragraph 8 of the Opposition.

9. Additionally, based on emails from Qualtrics, I believe that they are trying to "STRONG-ARM" me (FORCE ME) into selling the domain name to them at a lower price by making two 1B trademark registrations for marks they have never used in commerce. Qualtrics is a large company worth, in some estimates, up to 1.2 Billion Dollars so this wouldn't be the first time a large company has tried to intimidate an average citizen with limited financial resources. They can easily choose another name that is free instead of going after my name that I've used for 17 years.

RESPONSE: Applicant admits it filed 1(b) intent to use applications for the mark VOCALIZE. Applicant denies the remaining allegations contained in paragraph 9.

10. So, based on all this information from Qualtrics' own emails (nonuse and multiple notices of abandonment of the trademarks for Vocalize), I respectfully request that the powers that be at the USPTO cancel this and any other "Vocalize" trademark applications made by Qualtrics because their registrations will confuse my customer and the general public and they will dilute the use and value of my intellectual property and company names and, by their own admittance in emails above where they apologized, they have been acting in bad faith trying to force me to sell my domain name by making trademark registrations.

RESPONSE: Applicant denies the allegations contained in paragraph 10 of the Opposition.

Applicant denies any allegation not specifically admitted herein.

DEFENSES

1. Applicant asserts there is no likelihood of confusion between the Applicant's Application for VOCALIZE and Opposer's registrations. The goods and services provided by Applicant and applied for in the Application are not related to the goods and services registered by Opposer.

2. Applicant has prior use. Qualtrics purchased the rights associated with <vocalize.co> including trademark rights in the mark VOCALIZE for consumer surveys. The first use as evidenced by the United States Patent and Trademark Office trademark application

for the mark VOCALIZE as applied for by the third party dates back to January 1, 2013 which predates the date of filing for Opposer's cited registrations. Upon information and belief, Opposer cannot support an in use date of 1998.

3. Applicant reserves the right to add additional defenses based on discovery in this case.

PRAYER FOR RELIEF

WHEREFORE Applicant prays that the Opposition be dismissed in its entirety with prejudice and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Respectfully Submitted,

Date: October 26, 2015

DORSEY & WHITNEY LLP
By: s/ Scott P. Sinor
Scott Sinor
Jessie Pellant
1400 Wewatta Street, Suite 400
Denver, CO 80202
Tel: (303) 629-3400
E-mail: sinor.scott@dorsey.com
pellant.jessie@dorsey.com

ATTORNEYS FOR APPLICANT
QUALTRICS, LLC

CERTIFICATE OF SERVICE

I hereby certify that on October 26, 2015, the foregoing APPLICANT'S
AMENDED ANSWER TO NOTICE OF OPPOSITION was served upon the Opposer via
first class mail to the following with an email courtesy copy to venturait@gmail.com:

Mr. Jordan Older
1126 Via Arroyo Court
Ventura, CA 93003

s/ Karen Porter
Karen Porter
Dorsey & Whitney LLP